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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/765,046	11/15/96	TABATA	T 8279.146USWO

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IM51/1026

EXAMINER	
VANOY, T	
ART UNIT	PAPER NUMBER
1754	30

DATE MAILED: 10/26/00

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run _____ or continues to run THREE MONTHS from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, MAILED 17 OCT 00 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☒ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - b. ☒ They raise new issues that would require further consideration and/or search. (See Note).
 - c. ☒ They raise the issue of new matter. (See Note).
 - d. ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - e. ☒ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: PLEASE SEE THE ATTACHED PAPER FOR COMMENTS.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: 7, 8, 11 AND 22
Claims objected to: NONE
Claims rejected: 2-5, 10, 12 AND 15-21

However;

☐ Applicant's response has overcome the following rejection(s): (NONE)

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because OF THE REASONS OF RECORD AND THE REASONS SET FORTH IN THE REPLY PAPER
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☒ Other COPY OF PG. 453 IN THE "ATLAS OF ZED LITE STRUCTURE TYPES" ENCLOSED.

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Response to Amendment and Arguments

The Applicants' 116 Amendment mailed 17 Oct. 2000, which has been filed as Paper No. 29, has been considered.

- a) The proposed limitations to claims 15, 16 and 18 setting forth that a part of the metal is substituted by boron is not supported by original claim 11. Original claim 11 sets forth that part of the aluminum is substituted by boron. The proposed limitations to claims 15, 16 and 18 are not limited to the aluminum of original claim 11, but broadly recites "metal".
- b) In the proposed limitations to claims 15, 16 and 18, --is-- should be substituted in lieu of "being".
- c) The limitation "having a structure other than a beta structure" set forth in proposed claims 23 and 24 is not supported on pg. 6 in the Applicants' specification. On pg. 6 line 6 in the Applicants' specification, it is set forth that BEA (i. e. the "beta" of claims 23 and 24) is a preferred form (please note that pg. 453 in the "Atlas of Zeolite Structures" ^{TYPES} identifies BEA as beta).
- d) Proposed claims 25 and 26 introduce new issues which would require further consideration and/or search.
- e) The obviousness-type double patenting rejections over U. S. Pat. 5,869,013 is maintained. The amendments to claims 15, 16 and 18 have not been entered. New proposed claims 23-26 also have not been entered.

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f) The obviousness-type double patenting rejection over U. S. Pat. 5,985,225 is maintained because there is no evidence of record establishing that the argued spectral intensities for the catalyst set forth in claim 5 in U. S. Pat. 5,985,225 renders the limitations of Applicants' claim 4 unobviously distinct from claim 5 of U. S. Pat. 5,985,225.

g) The rejection of claims 19 and 21 under the first paragraph of 35 U.S.C. 112 is maintained because section 2163.02 in the MPEP (Rev. 1, Feb. 2000) clearly states that if a claim has been amended to include subject matter not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure as filed, the examiner should conclude that the claimed subject matter is not described in the specification and issue a 35 U.S.C. 112, first paragraph rejection. In this case, the specific use of "propane" in the Applicants' specification does not support the use of either "butane" or "ethane" as embraced in the scope of Applicants' claims 19 and 21.

h) The Applicants' arguments with respect to the rejection of claims 2-5, 10 and 15-17 as **not** being obvious from and/or anticipated from JP 5-220,403 because the Applicants' structures are directed to either substituted structures or non-BEA structures whereas JP 5-220,403 is directed to an unsubstituted BEA structure is not consistent with the scope of the pending claims, particularly since the proposed limitations in the 116 Amendment mailed Oct. 17, 2000 have not been entered.

i) The Applicants' arguments with respect to the rejection of claims 3, 15, 16 and 19-21 as **not** being obvious from and/or anticipated from Tamura (i. e. U. K. Patent Application 2,238,784

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A) because the Applicants' composition has 8-ring passages oriented in a first direction and 10-ring passages oriented in a second direction whereas Tamura's composition 8-ring passages and 10-ring passages oriented in different directions (rather than a plurality of 10-ring passages oriented in different directions) is not persuasive because the Applicants are claiming the same catalyst set forth in U. K. Pat. App'n. No. 2,238,784 A: please compare the cobalt-containing ferrierite zeolite described on pg. 4 (2nd full paragraph) and the paragraph bridging pages 5 and 6 in the Applicants' specification to the same cobalt-containing ferrierite taught in Table 2 on pg. 10 in U. K. Pat. App'n. No. 2,238,784 A.

j) The Applicants argue that they should have been given a better opportunity to file a Preliminary Amendment (since the Patent Office so quickly issued a Final Office Action after the CPA Request was filed), and, therefore, this 116 Amendment should be entered as a matter of right.

There is nothing in section 714.13 in the MPEP (Rev. 1, Feb. 2000) (particularly under the paragraph titled "ENTRY NOT A MATTER OF RIGHT") requiring that 116 Amendments be entered as a matter right due to the Patent Office's speedy examination and issuance of a previous Office Action. As a matter of fact, the MPEP clearly states: "It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims. . .".

Any inquiry concerning this communication should be directed to Timothy Vanoy at telephone number (703) 308-2540.

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25 Oct. 2000

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10/26/00